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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,463	09/15/2000	Charles Petruccelli	9547-3	3649

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662,463

Applicant(s)

PETRUCCELLI ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

3. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an

invention is eligible for a patent is to determine if the invention is within the "technological arts".

4. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
5. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

6. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.
7. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under

the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

8. Independent Claims 1, 8, 13, and 20 appear to be describing a method that is attempting to sell a destination information service, wherein customers are introduced to destination experts and the destination experts provide the customers' requested information. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.
9. Claims 2-7, 9-12, 14-19, and 21-26 are rejected as they are dependent on rejected independent claims.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauffer (US 6,223,165 B1).**

12. As per Claims 1, 8, 9, 13, and 20, Lauffer discloses a method (system, computer-readable storage, device) for providing travel-related information, comprising: communicating with a customer over a computer network, wherein communicating with the customer includes receiving contact information from the customer; identifying a plurality of experts, wherein the plurality of experts are in selective communication with a destination expert server; receiving from the customer a request relating to a destination city to which the customer is interested in traveling; selecting a destination expert of the plurality of experts, wherein the destination expert has particular knowledge about the destination city (Abstract, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).
13. Lauffer fails to expressly disclose forwarding the customer's request and the customer's contact information to the destination expert, such that the destination expert can communicate with the customer to provide response to the customer request.
14. However, Lauffer does disclose matching the customer with an expert, and supplying the customer with the experts contact information – so the customer can contact the expert to obtain information (C4 L46-60).
15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included forwarding the customer's request and the customer's contact information to the destination expert, such that the destination expert can communicate with the customer to provide response to the customer request, in the system disclosed by Lauffer, for the advantage of providing a method (system, computer-readable storage, device) for providing travel-related information, with the ability to

increase customer security by providing the customer with expert contact information, allowing the customer to remain anonymous.

16. As per Claims 2, 10, 14, and 21, Lauffer fails to expressly disclose wherein determining a destination expert comprises determining a destination expert of the plurality of experts, wherein the destination expert is located in the destination city or confirming that the destination expert is familiar with the destination.
17. However, Lauffer does disclose obtaining expert characteristics to include: details of expertise, address, and quality scores (Abstract, C1 L19-67, C2 L1-36).
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein determining a destination expert comprises determining a destination expert of the plurality of experts, wherein the destination expert is located in the destination city or confirming that the destination expert is familiar with the destination, in the system disclosed by Lauffer, for the advantage of providing a method (system, computer-readable storage, device) for providing travel-related information, with the ability to increase quality service by ensuring the experts have the qualification necessary to offer correct advice.
19. As per Claims 3, 15, and 22, Lauffer discloses wherein communicating with the customer over the computer network includes receiving a credit card number from the customer (Abstract, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).
20. As per Claims 4, 16, and 23, Lauffer fails to expressly disclose wherein the destination expert response includes an offer to book reservations relating to the customer request.

21. However, official notice is given that such reservation booking services were well known at the time the invention was made (see additional references in PTO-892), and it would have been obvious to include such a booking service in the system disclosed by Lauffer, for the advantage of providing a method (system, computer-readable storage, device) for providing travel-related information, with the ability to increase customer satisfaction by completing the travel related inquiry by booking the travel related service.
22. As per Claims 5, 17, and 24, Lauffer discloses receiving the destination expert response from the destination expert and forwarding the destination expert response to the customer (Abstract, Fig.1b, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).
23. As per Claims 6, 18, and 25, Lauffer discloses facilitating a transaction with the customer, wherein the transaction relates to the customer request (Abstract, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).
24. As per Claims 7, 19, and 26, Lauffer discloses monitoring communications of the destination expert server (Abstract, Fig. 1b, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).
25. As per Claim 11, Lauffer discloses wherein the destination expert server is accessible to the customer via the Internet (Abstract, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).
26. As per Claim 12, Lauffer discloses wherein the plurality of experts are in selective communication with the destination expert server via electronic mail (Abstract, C1 L19-67, C2 L1-36, C4 L46-67, C5 L1-10, C6 L1-28, Claims 1-19).

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. The following foreign patent is cited to show the best foreign prior art found by the examiner:

PCT No. WO 200167203 A2 to Ma

Ma discloses Travel agency system for Internet, which compares clients travel information and puts clients in contact with other clients whose travel information matches his e.g. same destination, tastes.

29. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

Willmott, Don, "Ask an Expert." PC Magazine, April 18, 2000.

Willmott discloses several systems on the Internet, which match customers up with experts who offered advice on a wide variety of subjects.

30. Additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-


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0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

33. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
November 5, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600